

Assents by personal representatives

What is an assent and why is it necessary?

A registered trade mark, or an application for registration of a trade mark, can be transferred on the death of one person to another (or to a company, unincorporated association or other entity) under the deceased person's will or intestacy (sections 27(2) and 31). A document called "assent" gives legal effect to the transfer. An assent relating to a registered trade mark, or an application for registration of a trade mark, must be in writing and signed by the personal representative(s) (sections 27(4) and 31). The personal representative(s) of a deceased person are the executors under a grant of probate of a will, or the administrator(s) under a grant of administration.

An assent is made by the personal representative(s) to a person (or other entity) entitled under the deceased person's will or intestacy. By contrast, the sale of a registered trade mark, or an application for registration of a trade mark, by personal representatives in the administration of a deceased person's estate is made by assignment, not by assent.

Why is a grant of representation in Hong Kong necessary?

A registered trade mark, or an application for registration of a trade mark, is personal property in Hong Kong (sections 27(1) and 31(1)). A grant of representation, that is a grant of probate or a grant of administration, must be obtained in Hong Kong for the administration of personal property in Hong Kong. This means that a grant of representation in Hong Kong must be obtained before an assent relating to a registered trade mark in Hong Kong, or an application for registration of a trade mark in Hong Kong, can be made. A grant obtained in Hong Kong (or resealed in Hong Kong) is necessary whether the deceased person died domiciled in Hong Kong or outside Hong Kong.

Application for a grant of representation in Hong Kong is made in the Probate Registry. A grant obtained in certain places outside Hong Kong can be resealed in Hong Kong (see the designated countries or places specified in Schedule 2 to the Probate and Administration Ordinance). A grant obtained outside Hong Kong (unless it can be resealed in Hong Kong) is not effective for the administration of personal property in Hong Kong.

Application of the new law

An assent relating to a registered trade mark, or an application for registration of a trade mark, is a registrable transaction. Unless an application or notice to register particulars of the assent is filed, the assent is ineffective as against a person acquiring a conflicting interest without knowledge of the assent (sections 29(2)(d), 29(3)(a) and 31).

Particulars of the assent should be filed before the end of the period of 6 months beginning on the date of the assent. Unless particulars are filed within the 6 months, a person who becomes the owner or licensee under the assent will not be entitled to damages or an account of profits for infringements for the period before particulars of the assent are registered (sections 29(4) and 31).

It is no longer necessary to produce the assent, or the grant of representation, when applying to register particulars, or when giving notice to register particulars, of the assent in the register if the application or notice is signed by or on behalf of the personal representatives (rule 62(4)).

Examining applications/notices to register particulars

Factors to be considered in examining applications/notices to register particulars of assents are listed below :

- Is the application to register particulars (relating to registered mark(s)) or notice

to register particulars (relating to application(s) for registration) made on the specified form, Form T10 (rule 62(1))?

- Was the specified fee (Fee No. 19) paid on filing? An application/notice to register particulars of one registrable transaction can relate to more than one registered mark or application for registration.

- Is the application/notice made by, and signed by or on behalf of, the personal representatives (sections 29(1)(b) and 31) or the person entitled under the assent (sections 29(1)(a) and 31)? If the application/notice is signed by or on behalf of the personal representatives, it does not need to be accompanied by documentary evidence of the transaction (rule 62(4)). If the application/notice is not signed by or on behalf of the personal representatives, it must be accompanied by documentary evidence of the transaction, for example, a copy of the assent (rule 62(4)), which will be open to public inspection (rule 69(1)(r)).

- Does the application/notice state :
 - the trade mark or application or any right in or under it vested by the assent (rules 62(1) and 63(1)(e)(i));
 - the name and address of the person entitled under the assent (rule 63(1)(e)(i));
and
 - the date of the assent (rule 63(1)(e)(ii))?

Registering particulars of an assent

The following matters are entered in the register :

- the name and address of the person entitled (rule 63(1)(e)(i));

- the date of the assent (rule 63(1)(e)(ii));
- the date of application or notice to register particulars of the assent (sections 29(3)(a), 29(4)(a) and 31);
- in case of a transfer of any right in or under the trade mark or application, a description of the right transferred; and
- the date on which the entry in the register is made (rule 63(2)).

Co-ownership

Co-owners are entitled to equal undivided shares in the registered trade mark, subject to agreement to the contrary (section 28(1)). In the case of a tenancy in common, on the death of a co-owner entitled to an equal undivided share, an assent is needed to transfer the deceased co-owner's interest to the other co-owner(s) or to some other person or entity. Particulars of the assent are registrable in the usual way (see *Examining applications/notices to register particulars* above).

Transitional provisions

The new law applies to applications to register particulars of assents filed on or after the commencement date (section 97; sections 8(1) and 8(6) of Schedule 5).

Applications filed before the commencement date under the old law and pending on the commencement date, to register a subsequent proprietor entitled under an assent, are treated as applications to register particulars under the new law (section 97; section 8(4) of Schedule 5). We may require the applicant to amend his application to register a

subsequent proprietor to conform with the requirements of the new law (section 97; section 8(5) of Schedule 5).

* * *

Previous version